

## REMARKS

Claims 6, 10-12, and 17-20 have been amended. No claims have been canceled. No new claims have been added. Claims 1-28 remain pending in the application.

### ***Support for Amendments***

#### **Claims**

Support for the amendment to claim 6 is found in Figures 1 and 3 and on page 10, lines 16-24.

The amendments to claims 10 and 11 are only to correct typographical errors.

Support for the amendment to claim 12 is found on page 13, lines 30-31 and page 14, lines 1-11.

Support for the amendments to claim 17-20 is found on page 2, lines 28-31 and page 3, lines 1-10.

### ***Objections/Rejections*** ***35 U.S.C. §112***

***1.0***    *The Examiner has objected to claims 6, 8-10, and 12-28 as indefinite for reciting elements lacking proper antecedent basis.*

(i)    *Claim 6*

Claim 6 has been amended to correct typographical errors and recite proper antecedent basis.

(ii) *Claim 8*

Claim 8 depends from claim 6 and the amendment to claim 6 corrects any improper antecedent basis in claim 8.

(iii) *Claim 9*

Applicant found no improper antecedent basis in claim 9 and asks the Examiner to clarify the rejection.

(iv) *Claim 10*

Applicant has amended claim 10 to correct a typographical error. The amendment corrects the improper antecedent basis.

(v) *Claim 12*

Applicant has amended claim 12 to correct the improper antecedent basis.

(vi) *Claims 13-16*

Claims 13-16 depend from claim 12. The amendment to claim 12 corrects any improper antecedent bases in claims 13-16.

(vii) *Claim 17*

Applicant has amended claim 17 to correct the improper antecedent basis.

(viii) *Claim 18*

Applicant has amended claim 18 to correct the improper antecedent basis.

(ix) *Claim 19*

Applicant has amended claim 19 to correct the improper antecedent basis.

(x) *Claim 20*

Applicant has amended claim 20 to correct the improper antecedent basis.

(xi) *Claims 21-22*

Claims 21-22 depend from claim 17. The amendment to claim 17 corrects the improper antecedent bases in claims 21-22.

(xii) *Claims 23-24*

Claims 23-24 depend from claim 18. The amendment to claim 18 corrects the improper antecedent bases in claims 23-24.

(xiii) *Claims 25-26*

Claims 25-26 depend from claim 19. The amendment to claim 19 corrects the improper antecedent bases in claims 25-26.

(xiv) *Claims 27-28*

Claims 27-28 depend from claim 20. The amendment to claim 20 corrects the improper antecedent bases in claims 27-28.

***Objections/Rejections  
Under 35 U.S.C. §102(f)***

**2.0** *The Examiner has rejected claims 1-28 as claiming subject matter not invented by the Applicant.*

Applicant filed his application as a continuation-in-part application ("CIP") of parent case 09/490,417 ("417"). The requirements for filing a CIP are (i) the CIP is filed before the patenting, abandoning, or termination of proceedings of the parent application, (ii) the CIP is filed by an inventor named in the parent application, and (iii) the CIP contains a specific reference to the parent application. 35 U.S.C. §120. Applicant has met all three requirements for filing a proper CIP application. The parent application '417 was abandoned after December 21, 2001 and applicant filed his CIP application on July 31, 2001. The CIP application has a common inventor to the parent application. Applicant was properly added as an inventor to the parent application '417. The CIP application contains a reference to the parent application '417 on page 1, lines 6-7. Therefore, applicant has satisfied all requirements to file a CIP application and the rejection based on 35 U.S.C. §102(f) should be withdrawn.

***Objections/Rejections  
Under 35 U.S.C. §102(e)(2)***

**3.0** *The Examiner has provisionally rejected claims 1-28 as anticipated by **Karsten** (U.S. 2003/0009840 A1).*

As previously set out in section 2.0, Applicant has filed a proper CIP claiming priority to parent application '417 of which Karsten's application is also a CIP. Therefore, as Applicant has filed a proper CIP application, applicant respectfully requests the Examiner withdraw the provisional rejection under §102(e)(2).

***Objections/Rejections  
Under 35 U.S.C. §102(b)***

**4.0**     *The Examiner has rejected claims 12-16 as anticipated by **Ampian** (U.S. 5,207,755).*

SUMMARY OF CITED REFERENCES

**Ampian** discloses an adjustable paint roller. The roller comprises a roller head, a support arm, a handle, and attachment means. The attachment means comprises three independent locking mechanisms allowing the handle to be moved in at least two degrees of freedom.

SUMMARY OF CLAIMED INVENTION

**A First Embodiment** of the present claimed invention (claims 12-28) is directed to a paint roller comprising a handle, a shaft, a functional element secured to a second end of the shaft, and an attachment means for repositioning the functional element relative to the handle. The attachment means is interposed between and connects a second end of the handle and a first end of the shaft and is configured to selectively position the functional element relative to the handle by providing a disengaged condition permitting repositioning of the shaft relative to the handle in at least two degrees of freedom, and an engaged condition preventing repositioning of the shaft relative to the handle. The engaged condition can be achieved with the shaft in at least two different positions relative to the handle.

LEGAL BASIS

An anticipation rejection under 35 U.S.C. § 102 requires that the cited reference(s) disclose each and every element of the claimed invention. *See, Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986); *Kloster Speedsteel AB et al. v. Crucible Inc. et al.*, 230 U.S.P.Q. 81, 84 (Fed. Cir. 1986). A reference anticipates a claim only when the reference discloses each and every element recited in the claim. *See, Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051 (Fed. Cir. 1987) and M.P.E.P. §2131. Accordingly, the “exclusion of a claimed element from a prior art reference is enough to negate anticipation by

that reference.” Atlas Powder Co. v. E.I. duPont De Nemours & Co., 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984).

A claimed invention may contain means-plus-function elements as set out in 35 U.S.C. §112 ¶6. The M.P.E.P. sets out a three prong analysis for determining when a claim limitation falls under 35 U.S.C. §112 ¶6: (i) the claim limitation must use the “means for” or “step for” phrase; (ii) the “means for” or “step for” must be modified by functional language; and (iii) the “means for” or step for” phrase must not be modified by sufficient structure, material, or acts for achieving the specified function. M.P.E.P. §2181 (Rev. 1, Feb 2003). A means-plus-function element in a claimed invention must be given the broadest reasonable interpretation in light of and consistent with the written description of the invention in the application. Id. citing In re Donaldson Co., 16 F.3d 1189, 1194 (Fed. Cir. 1994). An anticipation rejection under 35 U.S.C. § 102 of a claim containing a means-plus-function element requires that the cited reference(s) “...(i) performs the function specified in the claim, (ii) not be excluded by any explicit definition provided in the specification for an equivalent, and (iii) be an equivalent of the means- (or step-) plus-function limitation ...” M.P.E.P. §2183 (Rev. 1, Feb 2003). Equivalence may be shown by showing (i) the cited reference’s element performs the identical function specified in the claim in substantially the same way and produces substantially the same result, (ii) a person of ordinary skill in the art would have recognized the interchangeability of the cited reference element and the corresponding element disclosed in the specification, (iii) there are insubstantial differences between the cited reference element and the corresponding element disclosed in the specification, or (iv) the cited reference element is a structural equivalent of the claimed element disclosed in the specification. Id.

AMPIAN DOES NOT DISCLOSE EACH AND  
EVERY ELEMENT OF THE CLAIMED INVENTION.

FIRST EMBODIMENT

Ampian discloses an adjustable paint roller comprising a roller head, a support arm, a handle, and attachment means. The attachment means comprises three independent locking

mechanisms, each of which allow a segment of the support arm to rotate about a single axis and thereby permit the paint roller to be moved in two degrees of freedom relative to the handle. The attachment means in the claimed invention is a means-plus-function element under 35 U.S.C. §112 ¶6. The specification discloses a structure and acts for achieving the function. The structure disclosed in the application is a flexure joint which includes a spherical member or its equivalent, a receiving member configured and arranged to maintain and selectively engage the spherical member and a connector. (Page 3, lines 4-6) The disclosed structure allows repositioning of the functional element relevant to the handle in three degrees of freedom with a single mechanism. Accordingly, the structure of Ampian does NOT perform the claimed repositioning function in substantially the same way as the structure of the claimed invention, and therefore, does not disclose an equivalent attachment means. Hence, Ampian does not disclose each and every element of the claimed invention.

***Objections/Rejections  
Under 35 U.S.C. §103)***

**5.0** The Examiner has rejected claims 1-11 and 17-28 as obvious over **Ampian** (U.S. 5,207,755) or **Cayo** (U.S. 3,408,676) in view of **Cline** (U.S. 365,329).

**SUMMARY OF CITED REFERENCES**

**Ampian** discloses an adjustable paint roller. The roller comprises a roller head, a support arm, a handle, and attachment means. The attachment means comprises three independent locking mechanisms allowing the handle to be moved in at least two degrees of freedom.

**Cayo** discloses an angularly adjustable and frictionally held handle for paint rollers. The device comprises a roller head, a support arm, a handle, and attachment means. The attachment means disclosed allows repositioning and locking of the roller head about one axis only in relation to the handle. The disclosed attachment means is a circular friction plate.

**Cline** discloses an attachment means for a brush or pump handles comprising a ball and joint mechanism allowing motion of the handle about the joint in one degree of freedom.

## SUMMARY OF CLAIMED INVENTION

**A First Embodiment** of the present claimed invention (claims 12-28) is directed to a paint roller comprising a handle, a shaft, a functional element secured to a second end of the shaft and an attachment means for repositioning the functional element relative to the handle. The attachment means is interposed between and connects a second end of the handle and a first end of the shaft, and is configured to selectively position the functional element relative to the handle by providing a disengaged condition permitting repositioning of the shaft relative to the handle in at least two degrees of freedom, and an engaged condition preventing repositioning of the shaft relative to the handle. The engaged condition can be achieved with the shaft in at least two different positions relative to the handle.

**A Second Embodiment** of the present claimed invention (claims 1-11) is directed to a paint roller comprising a handle, a shaft, a functional element secured to a second end of the shaft and a flexure joint. The flexure joint comprises a spherical member, a receiving member configured and arranged to maintain and selectively engage the spherical member, and a connector in communication with the receiving member to releasably lock the spherical member in position.. The flexure joint is interposed between and connects a second end of the handle and a first end of the shaft. Repositioning of the spherical member as between a first and second locked position is effective for repositioning the shaft relative to the handle as between a first and second locked position.

## LEGAL BASIS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable



expectation of success must be found in the prior art, NOT in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). See, M.P.E.P. § 2143.

*THE AMPIAN, CAYO, AND CLINE REFERENCES  
DO NOT PROVIDE A MOTIVATION TO COMBINE THE  
TEACHINGS OF THE REFERENCES*

In order to prevent a hindsight-based obviousness analysis, the relevant inquiry for determining the scope and content of the prior art is whether there is a reason, suggestion, or motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to combine the references. See, In re Rouffet, 149 F.3d 1350, 1359, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998) ("[T]he Board must identify specifically ... the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Dembiczak, 175 F.3d 994, 999, 50 U.S.P.Q.2d at 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.") Obviousness may not be established by merely showing that the separate elements of the invention existed in the prior art. There must be some teaching or suggestion in the prior art to combine the elements. Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 119 F.3d 953, 43 U.S.P.Q.2d 1294, (Fed. Cir. 1997). While the references need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability must be "clear and particular." In re Dembiczak, 175 F.3d at 999, 50 U.S.P.Q.2d at 1617. See also, Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 43 U.S.P.Q.2d 1481 (Fed. Cir. 1997).

Ampian teaches and discloses three separate mechanisms for repositioning and locking a functional element of a paint roller relative to its handle. Ampian has a mechanism for each axis of movement. Cayo teaches and discloses a single mechanism for repositioning and locking a functional element of a paint roller relative to its handle about only one axis of movement. Cline teaches and discloses a mechanism for repositioning a brush or pump handle about only one axis of movement also. Cline is silent as to the intent and design of the mechanism in regards to whether the mechanism locks or whether the mechanism allows the attached handle or brush to move along

the axis of movement during use. The present claimed invention claims a single mechanism that provides movement about three axes and locks to prevent movement of the functional element during use. Accordingly, the structures of Ampian, Cayo and Cline do NOT disclose each and every element of the claimed invention.

Even if Cline's mechanism is assumed to lock, neither Ampian, Cayo, nor Cline provide any motivation to those persons skilled in the art to combine the teachings of these references. It is only through the use of forbidden hindsight that a motivation is found to combine these references.

### CONCLUSION

Applicant respectfully submits that all pending claims (claims 1-28) are in condition for allowance.

Respectfully submitted,

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By Elizabeth D. Lewen  
Elizabeth D. Lewen, #50,260  
SHERRILL LAW OFFICES, PLLC  
4756 Banning Avenue, Suite 212  
White Bear Lake, Minnesota 55110-3205  
(651) 426-2400